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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/818,997	03/28/2001	Raymund Sonnenschein	32301WC104	9757

441 7590 12/08/2004

SMITH, GAMBRELL & RUSSELL, LLP
1850 M STREET, N.W., SUITE 800
WASHINGTON, DC 20036

EXAMINER


MANOHARAN, VIRGINIA

ART UNIT PAPER NUMBER

1764

DATE MAILED: 12/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/818,997	Applicant(s) SONNENSCHEN ET AL.	
	Examiner Virginia Manoharan	Art Unit 1764	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Seiler (4,224,233) or Schilling (6,015,920) in view of Seiler ((4,196,139) and Bowman et al.

The above references are applied for the same reasons as set forth at pages 3 & 4 of the previous Office action.

Bowman et al applied to teach that the method or process wherein excess hydromethoxysilane is supplied in a reaction vessel under steady state operating conditions is known in the art. See col. 4, lines 58-60. To incorporate Bowman's teaching above, to the process of Seiler or Schilling would have been obvious to one of ordinary skill in the art in view of Bowman's suggestions at col. 3, lines 65-67 through col. 4, lines 1-9.

Applicant's arguments filed September 9, 2004 have been fully considered but they are not persuasive.

Applicants following argument such as: "...the cited prior art fails to depict the following features of independent claims 1 and 13; (1) a reaction column, (2) a silane excess, and (3) the claimed temperature range along the reaction column.

Thus, Applicants assert that Seiler and/or Schilling would not have been made it obvious to those of skill in the art to use the claimed method. The claimed method allows the preparation of propyl silanes with an unexpected lower content of by-product and high yield, as discussed on page 10 and shown by the Tables in the specification..." are not considered well taken because of the following reasons:

The above argued limitations (1) – (3) are taught or recognized in the prior art. Note e.g., the descriptions at the paragraph bridging pages 2 and 3 of the specification.

“...Additional approximately 28% trichlorosilane starting material is needed, with reference to the trichlorosilane quantity which went into the target product (see also DE 4119994 AI incorporated herein by reference). In order to make up for the trichlorosilane used up in producing the undesired side products (e.g. propylsilanes)..” (Underlining supplied). See also Bowman’s teaching, discussed *supra*. The argued temperature range is generally a result –effective variable. See e.g., col. 3, lines 55-60 of Seiler ‘233 temperature range which overlaps the claimed temperature. That is, Seiler discloses that “..Generally speaking, the temperature will depend upon the nature of the reactants and the prevailing pressure. Broadly speaking, the temperature can vary between 0° and 250° C., preferably between 50° and 180° C., with pressure and temperature being somewhat inversely proportional. ..”

Thus, in the absence of anything which may be “new” or unexpected result”, a *prima facie* case of obviousness has been established by the art and has not been rebutted.

Unexpected results must be established by factual evidence. Mere arguments or conclusory statements in the specification, applicants’ amendments, or the Brief do not suffice. *In re Lindner*, 457 F. 2d 506, 508, 173 USPQ 358 (CCPA 1972). *In re Wood*, 582, F. 2d 638, 642, 199 USPQ 137, 140 (CCPA 1978).

Applicant’s amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Virginia Manoharan whose telephone number is 571-271-1450. The examiner can normally be reached on Tuesday-Friday from 7:30 am to 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on (571) 272-1444. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

V. Manoharan/af
December 2, 2004

Handwritten signature
1764
12/6/04